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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,766	04/30/2001	James Talaric	4-01	4613
23713	7590	05/06/2004	EXAMINER	
GREENLEE WINNER AND SULLIVAN P C 5370 MANHATTAN CIRCLE SUITE 201 BOULDER, CO 80303			RAJGURU, UMAKANT K	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,766

Applicant(s)

TALARIC ET AL.

Examiner

Umakant K. Rajguru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29, 46 and 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 46 & 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. A response and a declaration have been filed on October 22, 2003.
2. Claims under examination are 1-29, 46 and 47.
3. Rejection of claims 2, 7 and 29 (see item 4 of Office Action of July 22, 2003) is now withdrawn. That of claims 5 and 6 is maintained since applicants' explanation is not convincing.
4. Rejection of claim 1 under 35 USC (102(b) (see item 6 of Office Action of July 22, 2003) is now withdrawn.
5. Claims 1-3, 5 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Graefe (USP 5002475).

Graefe discloses reaction injection molding apparatus, which is used to mold a shaped article from a polymerizable flowable resin-forming composition (abstract). One such composition has a thermosetting resin such a polyurethane elastomer of viscosity from 50 to 10,000 centipoises (column 1, lines 49-59; column 4, lines 41-44; column 10, lines 24 and 25).

Disclosure of Graefe, summarized above proves that above claims lack novelty.

6. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graefe (USP 5002475) in view of Kennedy et al (USP 6,290,614) and Hirai et al (USP 4,367,307).

Disclosure of Graefe is summarized earlier.

Graefe does not mention specifically organic pigment or dye (of instant claim 8), and colors (of instant claims 25-28).

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Kennedy uses white pigment with polyurethane (column 2, lines 42-51).

Hirai uses brown pigment with polyurethane elastomer (column 13, lines 45-45).

Therefore it would have been obvious to use in the composition of Graefe, (a) white pigment (of Kennedy) or (b) brown pigment (of Hirai) or any one or more of other pigments to impart specific color to the molded form or article.

It is noted that prior art is silent about certain limitations of some of above claims.

Since Graefe teaches mixing of colorants and other ingredients, it is reasonable to infer that the mixing is done uniformly throughout the mass. It is also obvious to use a pigment or a dye of a certain hardness to optimize the appearance and texture of surface of the molded article. It is also obvious (a) to adjust abrasion resistance of molded article so that any protruding material or flash can be removed by grinding with a sand paper (instant claim 12), (b) to adjust the composition to achieve certain impact strength (instant claim 13) and (c) to adjust certain physical properties (of instant claims 14-23).

7. Applicant's arguments filed October 22, 2003 have been fully considered but they are not persuasive. On page 9 of response the applicants state that " Graefe does not appear to disclose molded forms or mannequins". This statement is not persuasive because Graefe in column 1, lines 8-11 suggests to make molded articles. It is known in the art that colorants have to be uniformly mixed in the matrix.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, though Graefe is directed to an apparatus, specific disclosure in Graefe in column 4, lines 41-44 and in column 1, lines 49-59 cannot be totally ignored. Kennedy is a secondary reference, relied upon for its teaching of white pigment with polyurethane. Hirai is brought in for its suggestion to use brown pigment.

Applicants' conclusion (page 11) that the combination of references would neither teach nor suggest claimed invention is not convincing.

The submitted declaration by inventor Barber has been considered. It deals with short historical background of instant invention and some problems associated with retail mold forms. The declaration is devoid of any reasons to obviate cited rejection based on prior art. It is the examiner's position that what is presented in the said declaration is not new. Attempts have already been made by others to solve difficulties faced by instant inventors. These attempts have been successful. Hence even through the declaration provided some important and useful, information, it is not conducive to establish nonobviousness or anticipation of instant invention.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication from the examiner should be directed to U.K. Rajguru whose telephone number is (571) 272-1077. The examiner can generally be reached on Monday-Friday 9:30 am-6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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U.K. Rajguru/dh
April 29, 2004

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